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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,350	04/27/2001	Edward Aime Harycki	4013-1000	2471

7590 11/03/2003	EXAMINER
Lee, Mann, Smith, McWilliams, Sweeney & Ohlson	BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

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Chicago, IL 60690

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

SW

	Application No.	Applicant(s)
Office Action Summary	09/844,350	HARYCKI ET AL.
	Examiner	Art Unit
	Firmin Backer	3621

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 April 2003</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This is in response to a letter for patent filed on April 27th, 2001 in which claims 1-18 are

presented for examination. Claims 1-18 are pending in the letter.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

         (1) whether the invention is within the technological arts; and

         (2) whether the invention produces a useful, concrete and tangible result.

         For a claimed to be statutory, the claimed invention must be within the technological arts.

Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply,

involve, use, or advance the technological arts fail to promote the "progress of science and the

useful arts" and therefore are found to be non-statutory subject matter. For a method claim to

pass the muster, the recited method must somehow apply, involve, use, or advance the

technological arts.

         In the present case the inventive concept in claims 1-7 only recites an abstract idea. The

recited steps of obtaining data from a user determining profitability ... does not apply, involve,

use or advance the technological arts since all the steps can be performed in the mind of the user

or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly

recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the

claimed invention, as a whole, it not within the technological arts as explained above, claims 1-7

deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloan et al (U.S

PG Pub No. 2002/0111890).

5.   As per claims 1, 8 and 18, Sloan et al teach a method of offering a personalised financial

product comprising obtaining data from a user *(see paragraphs 0006, 0047, 0052)* determining

profitability characteristics of the user in dependence on the obtained data *(see paragraphs 0064)*

offering a financial product to the user, the financial product having a plurality of inter-related

cost-benefit parameters, the inter-relationship of the parameters being determined in dependence

on the profitability characteristics of the user, wherein the parameter settings are changeable by

the user, a change to one parameter setting having a corresponding effect on one or more of the

other parameter settings determined by the inter-relationship *(see paragraphs 0065, 0068)*

receiving acceptance of the financial product from the user *(see paragraph 0068)* and, creating a

financial product for the user, the product having characteristics determined in dependence on

the parameter settings accepted by the user *(see paragraphs 0076, 0077, 0078)* .

6.   As per claims 2, Sloan et al teach a method further comprising accepting updated

parameter settings from the user after creation of the financial product and updating the financial

product for the user in dependence on the updated parameter settings *(see paragraphs 0062-*

0064).

7.   As per claims 3, Sloan et al teach a method in which the data obtained from the user in

step (a) include selected ones of: employment data, financial data, personal data, home address,

and family data *(see paragraphs 0066, 0075)*.

8.   As per claims 4, Sloan et al teach a method in which the profitability characteristics

determined in include selected ones of: credit check for the user's name, fraud check for the

user's home address, background check on the user, projected likelihood of the user defrauding

or defaulting a payment against the provider, projected likelihood of the user transferring an

existing balance, projected monthly amount the user will spend, the projected likelihood the

user's account will go dormant, projected likelihood the user will move to another provider

projected usage, projected usage type and estimated timing of a user's lifecycle events (*see paragraphs 0066, 0075*).

9.   As per claims 5, Sloan et al teach a method in which the financial product is a selected one of: credit card, loan, mortgage, investment product or insurance product (*see paragraph 0058*).

10.   As per claims 6, Sloan et al teach a method in which the inter-relationship of parameters is selected from one of a set of inter-relationship parameters, each set being pre-calculated for users providing data fitting a predetermined range (*see paragraphs 0062-0064*) .

11.   As per claims 7, Sloan et al teach a method in which the inter-relationship of parameters is updated for an existing user based on actual data from the user's usage of the financial product (*see paragraph 0058*).

12.   As per claims 9 and 16, Sloan et al teach a computer implemented transaction system for the offer and management of financial products, a server is arranged to offer customisable financial products to users, to determine profitability characteristics of the user in dependence on obtained user details and generate a user interface having a plurality of inter-related cost-benefit parameters changeable by the user, the inter-relationship of the parameters being determined in dependence on the profitability characteristics of the user, wherein the parameter settings are changeable by the user, a change to one parameter setting having a corresponding effect on one

or more of the other parameter settings determined by the inter-relationship, the server being

arranged to receive an acceptance of the financial product from the user, and initiate the creation

of a financial product for the user, the product having characteristics determined in dependence

on the parameter settings *(see paragraphs 0064)*.

13.   As per claims 10, Sloan et al teach a computer implemented transaction system in which

the transaction system comprises a World Wide Web site, the server being arranged to host the

Web site *(see paragraphs 0037-0041)*.

14.   As per claims 11, Sloan et al teach a computer implemented transaction system in which

the server is connected to a database of parameter permutations, the server being arranged to

access the database and determine allowable parameter permutations according to the user's

details, the allowable parameter permutations being used to generate the user interface *(see*

paragraphs 0042, 0069, 0089).

15.   As per claims 12, Sloan et al teach a computer implemented transaction system in which

the database stores parameter permutations as coefficients to a predetermined equation, the

equation defining the inter-relationship between parameters *(see paragraph 0089, 0123)*.

16.   As per claims 13, Sloan et al teach a computer implemented transaction system in which

the database stores parameter permutations for each of a predetermined set of user details, the

server being configured to select the closest predetermined set corresponding to the user's details (*see paragraphs 0065, 0068*).

17.   As per claims 14, Sloan et al teach a computer implemented transaction system further comprising a user interface system downloadable onto a user terminal, the user interface system being operative to accept parameter permutations from the server, to generate and display the user interface in dependence on the parameter permutations, to accept user inputs changing the parameter settings and to communicate the selected parameter settings to the server (*see paragraphs 0042, 0069, 0089*).

18.   As per claims 15, Sloan et al teach a computer implemented transaction system in which the server is arranged to communicate with databases and data services to obtain data for calculating the profitability characteristics of the user, the databases and data services including: credit clearance, background checks, demographic data, business logic, household background databases and probability based systems (*see paragraphs 0066, 0075*).

19.   As per claims 17, Sloan et al teach a in which the data structure defines a plurality of inter-relationships, each inter-relationship having been pre-calculated for a range of profitability characteristics of a prospective user (*see paragraphs 0064*).
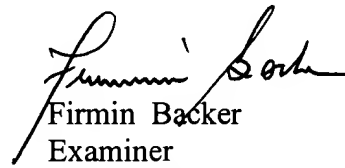
Conclusion

20.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. *(see form 892).*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-1113.

Firmin Backer
Examiner
Art Unit 3621

October 28, 2003